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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/405,242	09/24/1999	JOSEPH SILVESTER	9740-009-999	9272
23552	7590	11/02/2004		
MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER MAHMOUDI, HASSAN	
			ART UNIT 2165	PAPER NUMBER

DATE MAILED: 11/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/405,242

Applicant(s)

SILVESTER ET AL.

Examiner

Tony Mahmoudi

Art Unit

2165

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 September 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: 23-25.Claim(s) rejected: 1-22.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

  
**SAM RIMELL**  
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because:

The applicant's arguments presented in the After Final response, filed on 10-September-2004, have been fully considered but are not deemed persuasive are not deemed persuasive, and the claim limitations of the "finally rejected" claims are still met by the Bjorn (U.S. Patent No. 6,035,398), Buffam (U.S. Patent No. 6,185,316), Weiss et al (U.S. Patent No. 6,071,190), Douglass et al (U.S. Patent No. 6,021,426), Squilla et al (U.S. Patent No. 5,898,779), Chang et al (U.S. Patent No. 6,105,012), and Beatson et al (U.S. Patent No. 5,892,824) references:

In response to the applicant's arguments that "none of the cited references, however, teaches or even suggests the separate authentication of two different documents, which is a template for receiving user data and user data itself" have been fully considered but are not deemed persuasive, because although "separate authentication" appears in the preamble of the rejected claim, "separate authentication" of "two different documents, which is a template for receiving user data and the user data itself" are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, Bjorn teaches: "providing the template, the template having a corresponding template ID and template Document Authentication Code, hereinafter referred to as DAC(t), linked thereto" (see column 8, lines 62-65, where "DAC(t)" is read on "public key"); and he teaches: "generating a user data Document Authentication Code, hereinafter referred to as DAC(d), based on the user data" (see column 4, lines 25-30, where "DAC(d)" is read on "cryptographic key".)

In response to the applicant's arguments that "there is no motivation to combine the template Document Authentication Code of Buffam with the user data Document Authentication Code of Bjorn", the arguments have been fully considered but are not deemed persuasive, because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, motivation is established in the knowledge generally available to one of ordinary skill in the art to have modified Bjorn, by the teaching of Buffam, because including the template having template Document Authentication Code based on the template, would enable the method to authenticate templates based on its template Document Authentication Code, indicating template's true values and false values.